

REMARKS

Claims 20-39 remain in this application. Claims 1-19 were cancelled previously. Claims 20 and 30 have been amended. By these amendments, no new matter has been added. In addition, in response to the Notice of Non-Responsive Amendment mailed May 12, 2005, all references to new Claims 40-49 are deleted from these remarks. No new Claims 40-49 were intended to be presented, and remarks to the contrary were not intended. The amendment and remarks presented herein are otherwise in all material respects the same as the amendment and remarks filed February 14, 2005 in response to the Office Action dated September 20, 2004.

The present invention provides a method and system that permits aggregation of fully-qualified domain names, and the licensing of subdomain names, in ways that provides substantial advantages over the prior art. For example, using the method of the invention, popular fully-qualified names such as "man.com" or "pets.com" may be made available for licensing through a single portal. Although holders of fully-qualified domains were known to offer labels such as <http://members.aol.com/yourname> for use by their members (as disclosed, for example, by AOL98), such uses limit licensees of internet domains to a domain name including characters to the right of the root domain. The host name may frequently be much longer than is desired, may contain unwanted words, and is easily recognized as a mere member directory. Hence, it is not very valuable, and in fact, is usually provided for free.

The prior art does not permit a prospective licensee to conveniently shop for the most appropriate subdomain labels across a smorgasbord of available fully-qualified domain names. For example, a man named Ted Smith, who likes biking and boating and has a dog named Rover, might be willing to pay for the rights to ted.man.com, rover.dog.pets.com, ted.smith.com, ted.biker.com, and ted.boater.com. However, "man.com" "dog.pets.com" "smith.com" "biker.com" and "boater.com" are in all probability held by different parties, who typically do not offer licenses to subdomains.

Even if all holders offered subdomain licenses (which is clearly not the case in the real world), it would be at best inconvenient to seek separate licenses from all of them. Consequently, Ted will be deprived of his desired domain names. The economic opportunity to fulfill Ted's desires will likewise be lost, depriving holders of fully-qualified domains of their full economic value. Even though many prospective licensees may be interested in only a single domain name, essentially the same conclusion is reached: there is no convenient market for subdomain licenses for such domain names, and economic opportunity is therefore lost.

Likewise, the different holders of these and other fully-qualified domain names lack sufficient incentive to make subdomain labels available for licensing. The present invention overcomes this inertia by aggregating holders of disparate domain names, thereby attracting more prospective licensees. In turn, more prospective licensees attract more prospective licensors, and so on and so forth, until a robust and efficient market in subdomain labels is created.

In addition, a distinction should be made between domain names with subdomains to the right of the fully-qualified domain, separated from it by a "slash" character, and domain names with subdomain labels to the *left* of the fully-qualified name, separated by a dot. The former are instantly recognizable as mere member directories lacking a unique IP address. The latter, however, are generally reserved for use by the host of the fully-qualified domain, and may even be associated with an IP address in a zone file of a higher-level domain. Hence, domains that do not include label to the right of the fully qualified domain name are more desirable, in that they create a more favorable impression and may often be shorter. The present invention provides a method and system for creating a market for these more desirable domain names, unlike anything practiced in the prior art.

The Examiner rejected Claims 20-39 under 35 U.S.C. § 103(a) over Microsoft Press in view of AOL98 and Mann. These rejections are respectfully traversed. Microsoft Press, AOL98 and Mann both separately, and in combination, fail to disclose

or suggest:

- obtaining fully-qualified domain names associated with different corresponding host IP addresses in resource records of domain name servers from a plurality of domain name holders;

- communicating with the domain name servers to effect reassignment of name service records for the fully-qualified domain names, whereby the fully-qualified domain names are pointed to at least one IP address of a subdomain management system;

- maintaining a database of subdomain labels for the fully-qualified domain names, wherein each subdomain label is not associated with an IP address in a zone file of any higher-level domain, the database accessible by the subdomain management system and relating each subdomain label to a user-determinable address for content and to at least one of the fully-qualified domain names; and

- providing an interface interoperable with the database to relate user-selected subdomain labels with user-selected ones of the fully-qualified domain names to provide domain names, each domain name comprising a fully-qualified domain name and at least one subdomain label to the left of the fully-qualified domain name,

as defined by independent Claims 20 and 30. Moreover, none of the other references of record present any bar to patentability of Claims 20-39.

Microsoft Press merely discloses a dictionary definition of "Web site," that, at most, acknowledges that a single HTTP server may serve several small Web sites owned by individuals. Microsoft Press fails to disclose or suggest any element of the invention, including the step of obtaining fully-qualified domain names from a plurality of domain name holders. One of ordinary skill would have understood prior art methods for serving different Web sites from a single HTTP server to operate by associating

different domain names belonging to the different Web site owners with a *single* IP address of the HTTP host in a resource record of a domain name server. In contrast, the present invention operates by obtaining domain names associated with *different* host IP addresses in resource records of domain name servers. The invention operates in a manner contrary to that disclosed by Microsoft Press, and would therefore not have been obvious.

In addition, AOL98 does not make up for these deficiencies of Microsoft Press. In fact, AOL merely provides a specific embodiment of multiple Web site hosting as disclosed by Microsoft Press. In setting up individual Web sites for its members, AOL would not have needed to obtain domain names associated with *different* host IP addresses in resource records of domain name servers. Instead, as the sole holder of the fully-qualified domain name "aol.com," AOL already has the capacity to control all subdomains stemming off of it.

In addition, AOL fails to disclose the step of "communicating with the domain name servers to effect reassignment of name service records for the fully-qualified domain names," as defined by Claims 20 and 30. Being the sole holder of its root domain names, AOL would have had no reason or incentive to seek such reassignment of name service records. Indeed, the Examiner has not explained how AOL98 discloses this element of the invention. It is respectfully submitted that AOL98 and the other references do not disclose it.

Acknowledging the deficiencies of Microsoft Press and AOL98 with respect to the steps of maintaining a database and providing an interface, the Examiner cites Mann. Mann, however, merely discloses searching for available fully-qualified domains; e.g., a single second-level domain name plus a top-level domain such as "com," "org," and so forth. (See, e.g., Col. 4, lines 30-39.) Mann then discloses generating various permutations of available fully-qualified domain names for a prospective Web site operator to consider registering. (Id.; Col. 5, lines 33-46.) All of these suggested domain names, however, are second-level fully-qualified domain names with no third or

lower level subdomain element. Mann fails to disclose or suggest operating an interface for providing domain names wherein each domain name comprises "a fully-qualified domain name and at least one subdomain label to the left of the fully-qualified domain name." In Mann, nothing is placed to the left of the fully-qualified, two-level domain name. In fact, the essential purpose of Mann is to facilitate the process of finding available roots for domain names consisting of only two levels. (Col. 1, line 52 – Col. 2, line 28.) Mann therefore teaches away from providing names that include an additional subdomain label to the left of the fully-qualified domain name.

In addition, like Microsoft Press and AOL98, Mann fails to disclose or suggest communicating with domain name servers to effect reassignment. Instead, Mann discloses selecting an alternate second-level domain label if a particular fully-qualified domain name is not available. (Col. 5, lines 33-46.) Again, Mann teaches away from the sublicensing of labels to the left of a root domain, by disclosing consulting a database to determine whether a particular domain name is "for sale by owner" and therefore available. (Col. 5, lines 47-65.)

For at least the foregoing reasons, Microsoft Press, AOL98, and Mann, both separately and in combination, fail to disclose or suggest all the elements of independent Claims 20 and 30. No *prima facie* case of unpatentability has therefore been established to bar allowance of these claims, and these claims are therefore allowable. Claims 21-29 and 30-39 are also allowable, at least as depending from allowable base claims. These rejections should therefore be withdrawn.

In view of the foregoing, the Applicants respectfully submit that Claims 20-39 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited.

To the extent it would be helpful to placing this application in condition for allowance, the Applicants encourage the Examiner to contact the undersigned counsel and conduct a telephonic interview.

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While no fees are believed due in connection with the filing of this paper, the Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'B. Berliner', written over a horizontal line.

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